



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/420,991	10/20/1999	JONATHAN KEPECS	18477-000120	3518

7590 01/03/2002

GARY T AKA
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER
8TH FLOOR
SAN FRANCISO, CA 941113834

EXAMINER

PATEL, JAGDISH

ART UNIT

PAPER NUMBER

2164

DATE MAILED: 01/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

14-G

Office Action Summary	Application No.	Applicant(s)	
	09/420,991	KEPEC	
	Examiner	Art Unit	
	JAGDISH N PATEL	2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 20 October 1999.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-26,28-41 and 59-89 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-26,28-41 and 59-89 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 02

4) Interview Summary (PTO-413) Paper No(s). _____

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

Art Unit: 2164

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 28-31 and 33 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 28-31 and 33 depend on claim 27 which has been canceled by amendment.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-16, 21-26, 28-36 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Nichtberger et al. (US Pat. 4,882,675) and further in view of Deaton et al (US Pat. 5,687,322).

Art Unit: 2164

Claim 1: Nichtberger recites method for distributing and redeeming electronic promotions to a plurality of consumers through a communications network, comprising:

associating each consumer account with a unique key (col. 5 L 7-9, “UPC code (key) identifies the consumer”);

permitting access to said consumer account upon presentation of said unique key over said communications network (col. 5 L 7-11);

presenting promotion choices of items available at least one store associated with said unique key over said communications network (col. 4-7, the function of presenting promotion choices of items is performed by a local coupon distribution and redemption (CDR) unit 20) and performed over a communication network shown in fig. 1) ;

recording selections of said promotion choices made by said consumer over said communications network (col. 5 L 11-15);

receiving data of purchased items by said consumer at said associated store (col. 5 L 11-15); and

reconciling said selections and purchases to credit said consumer (col. 5 L 17-25).

While, the Nichtberger patent discloses “maintaining an account for each consumer”, it fails to teach that account has a direct identification of the consumer with the account to exclude identification of the consumer by name. However, identifying consumers without name, for example by an identification number is well known in marketing. In an exemplary reference, Deaton teaches a method for distributing and redeeming electronic promotions (marketing).

Art Unit: 2164

Refer to col. 5 L 12-43, “..using the identification number to search the customer database and to retrieve the corresponding customer record...”. Deaton thus teaches “maintaining an account for each customer with said account to exclude identification of said consumer by name”.

It would have been obvious to modify Nichtberger so that the consumer account is having a limited direct identification of the consumer with the account to exclude identification of the consumer by name per Deaton. Benefits of excluding the name of the consumer are maintain anonymity of the transactions whereby consumer is assured of his or her privacy so that personal data (including name) is not circulated for unsolicited advertisement material.

Claim 2 : The method of claim 1 wherein said reconciling step comprises recording a credit in said consumer account (Nichtberger col. 5 L 19-25, “automatically credits the customer.”).

Claim 3. The method of claim 2 wherein said consumer account comprises a financial institution account (Nichtberger: the consumer account is managed by the store where the purchase is made and account is settled col. 5 L 19-25).

Claim 4-10: Nichtberger or Deaton do not clearly recite the financial account as “deposit only” account.

Official Notice is taken the applying and recording the credits resulting from use of promotions to a variety of consumer financial accounts (such as a savings or checking account or an account setup by a retailer) are old and well known in the retail transactions process. It would have been obvious to one of ordinary skill in the art at the time of applicant’s invention to

Art Unit: 2164

include the alternative methods of applying the savings realized in the retail transaction (i.e. to one or more of a varieties of customer's financial accounts such as those recited in claims 4-10 using different methods) because in this manner a customer would have more choices of applying and managing the credits that he or she deems appropriate as a part of overall personal expense management and record keeping.

Claim 11. The method of claim 1 wherein said presenting promotion choices step comprises presenting specific discounts on specific items (Nichtberger col. 5 L 19-25, ..credits the customer for the coupons the customer has selected..).

Claim 12 and 13. The method of claim 1 wherein said presenting promotion choices step comprises presenting a purchase incentive for one or more items available in said associated store, said purchase incentive unrelated to said one or more items (The coupons presented to the customer (Nichtberger col. 5 L 4-7) incorporate these features because coupons are not just limited to monetary discount on a specific item. Coupons are issued as "buy 2 (item 1) get 1 (another unrelated item 2). Coupons are also offered to buy a specific item at a specific price.). Thus the features claimed herein are inherent in the Nichtberger system.

Claim 14. The method of claim 1 further comprising the step of sending data of said recorded selections to one or more of said associated stores within a preselected time limit after said recording selection step so that said data is sent prior to purchase of items by said consumer at said associated store (Nichtberger: since the checkout system 18 automatically credits the customer for the coupons as recited in col. 5 L 17-25 this feature is inherent in the reference).

Art Unit: 2164

Claim 15. The method of claim 14 further comprising the step of indicating discounts credited to said consumer account at the time of purchase of items by said consumer at said associated store (Nichtberger col. 11 L 35-45).

Claim 16. The method of claim 15 further comprising the step of invalidating said sent data of said recorded selections to one or more of said associated stores within a preselected time limit after said time of purchase of items by said consumer at said associated store (Nichtberger col. 18 L 10-15).

Claim 21. The method of claim 1 further comprising the step of sending data of said recorded selections to said associated store upon purchase of items by said consumer at said associated store so that discounts credited to said consumer account are indicated at the time of purchase of items by said consumer at said associated store (Nichtberger col. 17 L 49-56) .

Claim 22. The method of claim 1 wherein said receiving data of purchased items step occurs upon purchase of items by said consumer at said associated store (data of purchase items are “products actually being purchased Nichtberger col 17 L 52-55 see also L 62-66).

Claim 23. The method of claim 1 wherein said receiving data of purchased items step occurs within a preselected time limit after purchase of items by said consumer at said associated store (Day et al. Col. 5 L 35-36).

Regarding claims 24,25: Nichtberger et al do not incorporate the step of presenting data of previously purchased items by said consumer over said communication network to said consumer , however Deaton teaches and claims as invention (col. 149 claims 1-3) this step.

Art Unit: 2164

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to display previously purchased items by said consumer because this serves as added incentive along with the matching promotion so as to maintain a brand loyalty.

All other elements of the above claims are analyzed in claim 1.

Claim 26 The method of claim 1 wherein said consumer account maintaining step has a limited direct identification of said consumer with said account by an address (Deaton col. 16 L 51-64, “diffrent customer identification codes”).

Regarding claim 28: Nichtberger et al do not recite a database of only key, at least one financial institution and purchasing history, however in the same field of endeavor Deaton et al discloses a system and method for customer promotion comprising a database of customer identification and transaction data. Deaton incorporates a database comprising a unique customer identification code, a financial account number and a purchasing history for each customer (abstract and col. 64 L 66 col. 65 L 22) in the system. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate a unique customer identification code, a financial account number and a purchasing history for each customer in the customer account of the Nichtberger et al for offering targeted promotions and to facilitate crediting the discounts to one of the consumer's selected financial accounts because the promotion programs would be (a) directed more effectively to the targeted consumers and (b) consumer would receive a convenience of having his or her discount savings credited to a

Art Unit: 2164

separate preselected account where the purchases and the discount savings can be tracked for personal budgeting and record keeping purposes.

All other limitations of claim 28 are analyzed in claim 1 above.

Claims 29-31: financial account number..(refer to Deaton Col. 4 L 62-65, “check credit card, debit card or like”).

Regarding claim 32: Consumer account maintaining step includes a name of each customer (Nichtberger col. 4 L 4 L 54-62).

All other limitation of claim 32 are analyzed in claim 26 above.

Claims 33: Analyzed as in claim 28 respectively above.

Claim 34-36 : Nichtberger et al do not clearly teach that the access permitting step over the Internet , and through a Web site operated by the store.

Official Notice is taken that use of the Internet for product promotions through store Web sites is old and well known. (Nichtberger alludes to such alternative methods col. 27 L 55-61). It would have been obvious to one of ordinary skill in the art at the time of applicant’s invention to incorporate the access of the promotional system recited by the reference on the Internet through the WWW as recited in claims 34-36 (and claims 53-56) because the merchants would reach large number of customers at minimal cost who can participate in the promotional program.

All other limitations of the subject claims are analyzed in claim 1 .

Art Unit: 2164

5. Claims 17-20 and 37-41 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Nichtberger et al. (US Pat. 4,882,675) and further in view of Deaton et al (US Pat. 5,687,322) as discussed in claim 1 and further in view of Day et al. (US Pat. 5,857,175).

Claims 17: Whereas, Nichtberger or Deaton fails to teach inferring a likely associated store where purchases will occur by the consumer. Day in the same field of endeavor, however, teaches a method for offering targeted incentives to consumers (abstract) comprising inferring a likely store, col. 4 L 49-54). It would have been obvious to one of ordinary skill in the art at the time of the invention to implement the step of inferring a likely store where purchase will occur as claimed because associating the purchase with the store would facilitate incentive credit at the time of the consumer purchase at a predetermined store where the consumer is likely to purchase the item.

Claim 18. The method of claim 17 wherein said inferring step comprises inferring said likely associated store from the data of previously purchased items by said consumer (Day et al. Col. 7 L 42-50).

Claim 19. The method of claim 17 wherein said inferring step comprises inferring said likely associated store from said unique key (Day et al col.7 L 38-42).

Claim 20. The method of claim 14 wherein said one or more associated stores are preselected by said consumer (Day et al. Col.7 L 38-42).

Claim 37: Whereas, Nichtberger fails to teach that the promotions offered to consumer as being derived from received data of consumer purchases, in the same field of endeavor

Art Unit: 2164

however, Day et al teach a method for offering targeted promotions to the customers comprising the step of offering promotions to targeted individual consumers derived from received data of consumer purchases (col. 3 L 57- col 4 L 9). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate feature of selecting the promotions on the basis of the consumer's purchase history because the targeted promotions are more effective in generating sales.

All other limitation of claim 37 are analyzed in claims 26 and 106 above

Claim 38: The method of claim 37 wherein said promotion offering step comprises targeting large aggregates of consumers (Day et al. Col. 3 L 57-col 4 L 9).

Claim 39: The method of claim 37 wherein said promotion offering step comprises targeting individual consumers (Day et al. col 4 L 9).

Claim 40 : The method of claim 39 wherein said targeting step comprises inferring said individual consumers from purchasing and promotion selection data of said consumers (Deaton et al. Col. 4 L 10-24).

Claim 41: All limitations of claim 41 are analyzed in claims 12 and 40.

6. Claims 59-78 and 85-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nichtberger and further in view of Day.

Claim 59: Nichtberger recites method for distributing and redeeming electronic promotions to a plurality of consumers through a communications network, comprising:

Art Unit: 2164

maintaining an account for each consumer (col. 3 L 24-40) ;

associating each consumer account with a unique key (col. 5 L 7-9, "UPC code (key) identifies the consumer");

permitting access to said consumer account upon presentation of said unique key over said communications network (col. 5 L 7-11);

accepting offered promotions of at least one item from a promoter of said item over said communication network for presentation to consumers (customer selects coupons to be redeemed col. 5 L 9-11);

presenting promotion choices of items available at least one store associated with said unique key over said communications network (col. 4-7, the function of presenting promotion choices of items is performed by a local coupon distribution and redemption (CDR) unit 20) and performed over a communication network shown in fig. 1) ;

recording selections of said promotion choices made by said consumer over said communications network (col. 5 L 11-15);

receiving data of purchased items by said consumer at said associated store (col. 5 L 11-15); and

reconciling said selections and purchases to credit said consumer (col. 5 L 17-25).

Nichtberger, fails to teach accepting promotions for presentation to consumers are from a promoter of a item.

Art Unit: 2164

In the same field of endeavor, however, Day teaches a method for distributing and redeeming electronic promotions. Day teaches accepting promotions over a telecommunication network of an item for presentations to consumers wherein the offered promotions are from a promoter of the item (col. 7 L 14-26, computer 16 communicate with manufacturers...). It would have been obvious to one of ordinary skill in the art at the time of invention to modify Nichtberger to implement communication with the promoter (e.g. manufacturers) for presentation to consumers. This improvement would allow the promoters (such as manufacturers) to promote their products to targeted consumers and would provide the store owners to jointly promote the items with other promoters which would improve the economy of the promotion.

Claim 60 and 61. Accepting offered promotion step further includes at least one criterion for item and offering ..through GUI (..particular targeted offer, Day, col. 7 L 13-26, GUI inherent).

Claim 62. The method of claim 59 wherein said presenting promotion choices step comprises presenting specific discounts on specific items (Nichtberger col. 5 L 19-25).

Claim 63 and 64. The method of claim 59 wherein said presenting promotion choices step comprises presenting a purchase incentive for one or more items available in said associated store, said purchase incentive unrelated to said one or more items (The coupons presented to the customer (col. 5 L 4-7) incorporate these features because coupons are not just limited to monetary discount on a specific item. Coupons are issued as “buy 2 (item 1) get 1 (another

Art Unit: 2164

unrelated item 2). Coupons are also offered to buy a specific item at a specific price.). Thus the features claimed herein are inherent in the Nichtberger system.

Claim 65. The method of claim 59 further comprising the step of sending data of said recorded selections to one or more of said associated stores within a preselected time limit after said recording selection step so that said data is sent prior to purchase of items by said consumer at said associated store (since the checkout system 18 automatically credits the customer for the coupons as recited in col. 5 L 17-25 this feature is inherent in the reference).

Claim 66. The method of claim 65 further comprising the step of indicating discounts credited to said consumer account at the time of purchase of items by said consumer at said associated store (col. 11 L 35-45).

Claim 67. The method of claim 15 further comprising the step of invalidating said sent data of said recorded selections to one or more of said associated stores within a preselected time limit after said time of purchase of items by said consumer at said associated store (Nichtberger col. 18 L 10-15).

Claims 68: Whereas, Nichtberger fails to teach inferring a likely associated store where purchases will occur by the consumer. Day in the same field of endeavor, however, teaches a method for offering targeted incentives to consumers (abstract) comprising inferring a likely store, col. 4 L 49-54). It would have been obvious to one of ordinary skill in the art at the time of the invention to implement the step of inferring a likely store where purchase will occur as claimed because associating the purchase with the store would facilitate incentive credit at the

Art Unit: 2164

time of the consumer purchase at a predetermined store where the consumer is likely to purchase the item.

Claim 69. The method of claim 68 wherein said inferring step comprises inferring said likely associated store from the data of previously purchased items by said consumer (Day et al. Col. 7 L 42-50).

Claim 70. The method of claim 68 wherein said inferring step comprises inferring said likely associated store from said unique key (Day et al col.7 L 38-42).

Claim 71. The method of claim 65 wherein said one or more associated stores are preselected by said consumer (Day et al. Col.7 L 38-42).

Claim 72. The method of claim 59 further comprising the step of sending data of said recorded selections to said associated store upon purchase of items by said consumer at said associated store so that discounts credited to said consumer account are indicated at the time of purchase of items by said consumer at said associated store (col. 17 L 49-56) .

Claim 73. The method of claim 59 wherein said receiving data of purchased items step occurs upon purchase of items by said consumer at said associated store (data of purchase items are “ products actually being purchased col 17 L 52-55 see also L 62-66).

Claim 74. The method of claim 59 wherein said receiving data of purchased items step occurs within a preselected time limit after purchase of items by said consumer at said associated store (Day et al. Col. 5 L 35-36).

Art Unit: 2164

Regarding claims 75,76: Nichtberger et al do not incorporate the step of presenting data of previously purchased items by said consumer over said communication network to said consumer , however Deaton teaches and claims as invention (col. 149 claims 1-3) this step. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to display previously purchased items by said consumer because this serves as added incentive along with the matching promotion so as to maintain a brand loyalty.

Claim 77. The method of claim 59 wherein said consumer account maintaining step has a limited direct identification of said consumer with said account (col. 5 L 46-56).

Claim 78. The method of claim 77 wherein said consumer account maintaining step excludes identification of said consumer by name (customer is identified by UPC code, col. 2 L 46-59).

Claim 85: Nichtberger fail to teach that the promotions offered to consumer as being derived from received data of consumer purchases, in the same field of endeavor however, Day et al teach a method for offering targeted promotions to the customers comprising the step of offering promotions to targeted individual consumers derived from received data of consumer purchases (col. 3 L 57- col 4 L 9). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate feature of selecting the promotions on the basis of the consumer's purchase history because the targeted promotions are more effective in generating sales.

All other limitation of claim 37 are analyzed in claims 26 and 106 above

Art Unit: 2164

Claim 86: The method of claim 37 wherein said promotion offering step comprises targeting large aggregates of consumers (Day et al. Col. 3 L 57-col 4 L 9).

Claim 87: The method of claim 37 wherein said promotion offering step comprises targeting individual consumers (Day et al. col 4 L 9).

Claim 88: The method of claim 39 wherein said targeting step comprises inferring said individual consumers from purchasing and promotion selection data of said consumers (Deaton et al. Col. 4 L 10-24).

Claim 89: All limitations of claim 89 are analyzed in claims 12 and 40.

7. Claims 79-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nichtberger and further in view of Day as applied to claim 59 and further in view of Deaton.

Regarding claim 79: Nichtberger or Day do not recite a database of only key, at least one financial institution and purchasing history, however in the same field of endeavor Deaton et al discloses a system and method for customer promotion comprising a database of customer identification and transaction data. Deaton incorporates a database comprising a unique customer identification code, a financial account number and a purchasing history for each customer (abstract and col. 64 L 66 col. 65 L 22) in the system. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate a unique customer identification code, a financial account number and a purchasing history for each customer in the customer account of the Nichtberger et al for offering targeted promotions and to

Art Unit: 2164

facilitate crediting the discounts to one of the consumer's selected financial accounts because the promotion programs would be (a) directed more effectively to the targeted consumers and (b) consumer would receive a convenience of having his or her discount savings credited to a separate preselected account where the purchases and the discount savings can be tracked for personal budgeting and record keeping purposes.

Claims 80-82: financial account number..(refer to Deaton Col. 4 L 62-65, "check credit card, debit card or like").

Regarding claim 83: Consumer account maintaining step includes a name of each customer (Nichtberger col. 4 L 4 L 54-62).

All other limitation of claim 83 are analyzed in claim 77 above.

Claims 84: Analyzed as in claim 79 respectively above.

Prior Art Cited

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official faxes to Technology Center 2100 is (703) 746-7239 or 7238. Draft or Informal faxes for

Art Unit: 2164

this Art Unit can be submitted to (703) 746-7240. **Draft faxes may also be submitted directly to the examiner at (703) 746-5563.**

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

JNP 12/26/01

VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100